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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,114

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Adam Bruce

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EXAMINER

GOUGH, TIFFANY MAUREEN

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

11/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/574,114	<b>Applicant(s)</b> BRUCE ET AL.	
	<b>Examiner</b> TIFFANY M. GOUGH	<b>Art Unit</b> 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 14, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-13, 15, 16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/06, 5/22/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1,3-6,11 and 19 in the reply filed on 7/17/2008 is acknowledged. Applicants amendment filed 7/17/2008 has been received and entered. Applicant requests that amended claims 2,12-16, 20 now be included in Group I.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 7-10,14,17,18 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1-6, 11-13, 15-16, 19, 20 have been examined on the merits.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 16, 19, 20 and the further dependent claims 2-6,11-13, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 requires predetermined substances. It is not clear from applicants claim or specification how one would “predetermine” the substance. Further, claim 1 is indefinite in that it states allowing or preventing substances from one side or another of substances that are the same or different from the substances. It is not clear what is exactly happening in applicants invention and what is or is not being allowed or prevented to diffuse.

Further, claims 1, 11,12 claim “the other opposite side...” it is not clear what “other” opposite side there could be. Is there **another** opposite side? Simply “the opposite side” would correct the redundancy and confusion.

Regarding claim16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 16, 19 and 20 are indefinite because both are ultimately dependent upon claim 1, claim 1 only requires one coating. Claims 16,19 and 20 state, “...at least one of the coatings...” Therefore the claims lack antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6,11-13,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Khan (US 5387327).

Khan teaches an implant comprising a semipermeable barrier coated with a bioactive metal such as titanium which allows or prevents diffusion of substances, material and molecules to the opposite side of the barrier (col. 3, lines 50-68). The substances are produced in a human or animal body, i.e. blood sugar (col.4 -5, claim 1). Khan teaches the titanium to be deposited by spray deposition, i.e. an atomizing process (col. 4, lines 30-35). The implant further comprises a sensor element enclosed by a membrane (col.3, lines 25-68, col. 4, lines 40-51). The sensor is disclosed as being a blood sugar detecting sensor element (col.4, col. 5, claim 1).

Thus, the reference anticipates the claimed subject matter.

Claims 1-5, 11, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by LaVan et al. (Nature Biotech, Sept. 2003).

LaVan teaches an implant comprising a semipermeable barrier coated with a bioactive metal such as titanium which allows or prevents diffusion of substances, material and molecules to the opposite side of the barrier (p.1186 Chambers section, Fig. 2 and 3). The substances are produced in a human or animal body, i.e. cells, insulin, interferon.

Thus, the reference anticipates the claimed subject matter.

Claims 1-5, 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Peery et al. (US 2003/0108590 A1).

Peery teaches an implant comprising a semipermeable barrier coated with a bioactive metal such as titanium which allows or prevents diffusion of substances, material and molecules to the opposite side of the barrier (0041,0044-46). The substances are produced in a human or animal body, i.e., insulin (0063).

Thus, the reference anticipates the claimed subject matter.

Claims 1-3, 11, 12, 13, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Brauker et al. (US 5782912).

Brauker teach an implant comprising a semipermeable barrier coated with a bioactive metal (col14., lines 15-17) which allows or prevents diffusion of substances, material and molecules to the opposite side of the barrier (col.3, lines 55-60, col. 4, lines 8-12, col, 6, lines 53-68, col. 7, lines 40-45 ). The substances are produced in a human or animal body, i.e., blood sugar (col. 13, lines 64-68). The implant further comprises a sensor element enclosed by a membrane (col.5, lines 37-42, col. 13, lines 64-col. 14, lines 1-20). The sensor is disclosed as being a blood sugar detecting sensor element (col. 13, lines 64-col. 14, lines 1-20).

Thus, the reference anticipates the claimed subject matter.

Claims 1-3, 11, 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Antananvich et al. (US 6372244 B1).

Antananvich teach an implant comprising a semipermeable barrier coated with a bioactive metal, i.e. barium and calcium (col. 20, lines 30-35) which allows or prevents diffusion of substances, material and molecules to the opposite side of the barrier (abstract, col.19, lines 10-20, col. 20, lines 55-61, col.21, lines 27-28). The substances are produced in a human or animal body, i.e., cells (col. 19, lines 50-53, col. 21, lines 13-20).

Thus, the reference anticipates the claimed subject matter.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIFFANY M. GOUGH whose telephone number is (571)272-0697. The examiner can normally be reached on M-F 8-5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1657

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ralph Gitomer/  
Primary Examiner, Art Unit 1657

/Tiffany M Gough/  
Examiner, Art Unit 1657